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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,360	06/28/2001	Harukazu Fukami	001560-403	2680

7590

07/19/2004

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EXAMINER

RAYMOND, RICHARD L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

314.

Office Action Summary

Application No.

09/869,360

Applicant(s)

FUKAMI ET AL.

Examiner

Richard L. Raymond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004 and 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Response of April 30, 2004 canceled claims 11, 12, 15 and 16. Accordingly, the claims now pending are claims 13, 17 and 18.
2. In view of the arguments and amendments presented in the response, the rejections over all the prior art except Fukami et al., U.S. Patent No. 5,814,631, have been overcome. It is noted that EP 795,548 of record is cumulative with this Fukami et al. patent, and WO 00/10982 has been overcome by the submission of an English translation of applicants' priority papers in the Response of May 21, 2004.

Obviousness-type Double Patenting

3. Claims 13, 17 and 18 are again are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-21 of U.S. Patent No.5,814,631. Applicants' arguments have been considered but are seen persuasive of error in the present rejection. As noted in the last Office action, the same hosts are being treated for the same diseases by the same compounds. Discovery of the specific mechanism or mode of action of the method does not render the present method patentable. The same process is involved. The same compounds are being administered to treat the same diseases. The present mode of action would, in fact, be inherently present.

4. Claims 13, 17 and 18 are again provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 of copending Application No. 09/763,213. Again the same compounds are being administered to treat the same disease. Note, also that claim 17 of the '213 application does not recite any mode of action. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Different Inventive Entity, Common Ownership

5. Claims 13, 17 and 18 are directed to an invention not patentably distinct from claims 5-21 of commonly assigned U.S. Patent No. 5,814,631 and claims 16 and 17 of commonly assigned Application No. 08/763,213. See the rejections above.

6. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent No. 5,814,631 and Application No. 08/763,213, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in

this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

7. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 102 / 35 USC § 103

8. Claims 13, 17 and 18 are again rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukami et al. '631 for the reasons of record. See the rejection in the obviousness-type double patenting rejection above.

Conclusion

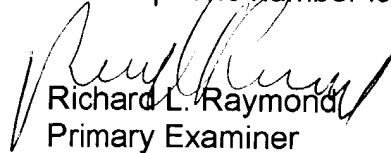
9. This action is **not** made final in view of the new issue presented in paragraphs 5-7 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Richard L. Raymond
Primary Examiner
Art Unit 1624

rr

July 14, 2004